

## **REMARKS**

### **INTRODUCTION**

The Office Action dated April 11, 2005 and the references cited therein have been carefully considered. In response, the applicant offers the following remarks and respectfully requests reconsideration and withdrawal of the rejections identified below.

### **OFFICE ACTION REJECTIONS**

Claim 1-4 and 7-24 are rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over the Odyssey gaming machine by Silicon Gaming Inc. circa 1997 (the "Odyssey gaming machine") in view of Scott et al. (U.S. Des. Pat. No. 395,463), Hedrick et al. (U.S. Patent No. 6,135,884) and Carmean (U.S. Patent No. 4,517,654).

Claim 5 is rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over the Odyssey gaming machine in view of Scott et al., Hedrick et al., Carmean and Pascal et al. (U.S. Patent No. 6,287,202).

Claim 6 is rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over the Odyssey gaming machine in view of Scott et al., Hedrick et al., Carmean, Pascal et al. and Alcorn et al. (U.S. Patent No. 6,104,815).

### **SYNOPSIS OF CITED REFERENCES**

Odyssey Gaming Machine, Silicon Gaming, Inc. Circa October 1997: A gaming machine capable of displaying a menu of a variety of available games that may be played. The games include slot games ("Win-O-Matic," "Dazzling Diamonds," "Fort Knox"), video poker ("Phantom Belle"), and video keno ("Star Spangled Keno," "Krazy Keno"). Each game includes video images displayed on a display screen.

Scott et al.: An ornamental design for an electronic gaming machine.

Hedrick et al.: A gaming machine having a main display and a secondary display for presenting video content including primary, secondary or tertiary information.

Carmean: A method and apparatus for simultaneously displaying portions of a stationary image and a moveable image on a video display. A stationary image plane is used for stationary images and a moveable image plane is used for moveable images.

Pascal et al.: A tournament gaming method and system, including a plurality of gaming terminals selectively interlinkable with a host terminal. Players of the terminals desiring to participate in group tournament play can be notified of the opportunity and provided with the choice to play.

Alcorn et al.: A method and apparatus for providing authenticated, secure, on-line communication between remote locations. A user terminal enables a player in one location to remotely communicate via a communications medium (e.g., the Internet) with a gaming host in another location.

### **INTERVIEW SUMMARY**

On June 7, 2005, Applicants' attorney, Aaron M. Peters (Reg. No. 48,801) conducted a telephonic interview with Examiner Michael W. O'Neill in which the independent claims were discussed. During that interview, Examiner O'Neill indicated that the independent claims, and all claims dependent thereon, would be reconsidered in light of the above amendments. Although a final agreement was not reached with regard to the claims, the examiner indicated that the amendments and accompanying remarks were likely to overcome the current rejections.

As referenced in the Interview Summary of June 15, 2005, and as indicated by the examiner during the interview, the Odyssey Gaming Machine does not disclose a plurality of first displayed items, such as playing cards (claims 1, 18 and 21), keno number spaces (claim 7) or a bingo card number spaces (claim 13), that change to display a display object inside the first displayed items wherein the portions of the display object create a single, identifiable composite object other than the first displayed items.

In contrast, the Odyssey gaming machine presents a menu on a video display screen displaying a variety of available games that may be played on the gaming machine. Video images for each of the games are displayed, including images for a vintage mechanical reel slot machine ("Win-O-Matic"), modern video slot machines ("Dazzling Diamonds" and "Fort Knox"), video poker ("Phantom Belle"), and video keno ("Star Spangled Keno" and "Krazy

Keno"). The Odyssey gaming machine may display video images such as slot machine reels, playing cards and keno cards. However, the Odyssey gaming machine, as disclosed in the Odyssey Gaming Machine Brochure, does not progressively change the display inside game display elements to display a portion of a single, identifiable composite display object other than the game display elements.

### **ARGUMENTS FOR PATENTABILITY**

Turning to the rejections of claims 1-11, 13-16 and 18-24 under 35 U.S.C. Sec. 103(a), based on the cited references, the applicant respectfully submits that the Office Action fails to present a *prima facie* case of obviousness, inasmuch as the cited references fail to disclose or suggest all of the limitations recited in the independent claims, whether taken alone or in combination. As set forth in MPEP section 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

### **MISSING AND UNSUGGESTED ELEMENTS**

All of the pending independent claims call for a plurality of first displayed items, such as playing cards (claims 1, 18 and 21), keno number spaces (claim 7) or a bingo card number spaces (claim 13), to change to displaying a display object inside the first displayed items wherein the portions of the display object create a single, identifiable composite object other than the first displayed items.

In contrast, the Odyssey gaming machine presents a menu on a video display screen displaying a variety of available games that may be played on the gaming machine. Video images for each of the games are displayed, including images for a vintage mechanical reel slot machine ("Win-O-Matic"), modern video slot machines ("Dazzling Diamonds" and "Fort Knox"), video poker ("Phantom Belle"), and video keno ("Star Spangled Keno" and "Krazy Keno"). The Odyssey gaming machine may display video images such as slot machine reels, playing cards and keno cards. However, the Odyssey gaming machine does not progressively change the display inside game display elements to display a portion of a single, identifiable composite display object other than the slot machine reels, playing cards and keno cards.

In particular, the images of the slot machine reels of the Odyssey gaming machine do not progressively change to portions of a display object that create a single, identifiable composite image other than the images of the slot machine reels as called for in the pending claims. While the slot machine reels appear to spin, the slot machine reels and the images thereon do not change to portions of a display image that collectively create a single identifiable composite image different than the slot machine reels. Likewise, the images of the playing cards (front or back) do not progressively change to portions of a display object that create a single, identifiable composite image other than the playing cards (front or back). Although the playing cards change from displaying backs to displaying fronts as a virtual dealer deals the playing cards, the playing cards do not progressively change from card fronts or card backs to portions of a display object that collectively create a single identifiable composite image different than the playing cards (front or back). Further, the images of keno numbers do not progressively change to portions of a display object that create a single identifiable composite image other than the keno numbers. Although the keno number spaces may be marked to indicate selected numbers, the keno number spaces do not progressively change from keno numbers to portions of a display object that collectively create a single identifiable composite image different than the keno numbers.

Scott et al. teaches a design for a gaming machine. Scott et al. does not disclose any display images, much less disclose or suggest progressively changing a plurality of first displayed items to each display a portion of a display object inside the first displayed items, where the portions of the display object create a single, identifiable composite image other than the first displayed items.

Hedrick et al. teaches a secondary display in a gaming machine for providing video content, but does not teach or suggest progressively changing first displayed items to portions of a display object that create a single, identifiable composite image other than the first displayed items. Although game displays may be generated on the primary display (spinning reels), the spinning reels and the images thereon do not change to portions of a display image that collectively create a single, identifiable composite image other than the spinning reels and the images thereon. Likewise, although displays may be generated on the secondary display (e.g., messages, animations, paytables, bonus games, etc.), the images do not change to portions of a display image that collectively create a single, identifiable composite image other than the first displayed images. For example, the secondary display may generate an

image of a thermometer reading rising with each payout, an image of diamonds conveyed to a cart based on the slot results on the primary display, an image of cherries conveyed to a pie based on the slot results, images of the number seven moving across the display in correspondence with the slot results or an image of a spinning wheel. However, none of these images involve changing a plurality of first displayed items to each display a portion of a display object inside the first displayed items, where the portions of the display object create a single, identifiable composite image other than the first displayed items.

Carmean teaches a method and apparatus for simultaneously displaying portions of a stationary image and a moveable image on a video display. Carmean creates and displays a stationary image plane for stationary images and a moveable image plane for moveable images, such that, for example, an image of the number seven may move across a stationary image to give the impression of slot reel motion or rotation. However, the neither the moveable images nor the stationary images involve changing a plurality of first displayed items to each display a portion of a display object inside the first displayed items, where the portions of the display object create a single, identifiable composite image other than the first displayed items.

On the other hand, each of the independent claims specifies a manner in which an image is displayed that is distinct from the cited references. For instance, claim 1, and claims 2-6 by implication, recite a controller being programmed to display on the gaming display a plurality of playing cards where the playing cards change in a predetermined, non-random sequence at a predetermined speed from displaying one of card backs and card fronts to displaying a portion of a display object inside the playing cards wherein the portions of the display object create a single identifiable composite image other than the cards fronts and the card backs. The Odyssey gaming machine fails to disclose or suggest each of the following elements and related function of claims 1-6:

(i) the display of a plurality of playing cards where the playing cards change from displaying one of card backs and card fronts to displaying a portion of a display object inside the playing cards; and,

(ii) wherein the portions of the display object create a single identifiable composite image other than said card backs and said card fronts.

Claim 7, and claims 8-12 by implication, also recite elements relating to the manner of displaying the portions of the display object inside the Keno number spaces. As a result, and for the reasons set forth hereinabove in connection with claims 1-6, the Odyssey gaming machine fails to disclose or suggest each of the following elements and related functions (attracting players to the image and the specific game) of claims 7-12:

(i) the display of a plurality of keno number spaces in a keno game where the keno number spaces change in a predetermined, non-random sequence at a predetermined speed from displaying keno numbers to displaying a portion of a display object; and,

(ii) wherein the portions of the display object create a single identifiable composite image other than said keno numbers.

Similarly, and for the reasons set forth hereinabove in connection with claims 1-6, the Odyssey gaming machine also fails to disclose or suggest each of the following elements and related functions (attracting players to the image and the specific game) recited in claim 13, and claims 14-17 by implication:

(i) the display of a plurality of bingo number spaces in a bingo game where the bingo number spaces change in a predetermined, non-random sequence at a predetermined speed;

(ii) where the bingo number spaces change from displaying bingo numbers to displaying a portion of a display object; and,

(iii) wherein the portions of the display object create a single identifiable composite image other than said bingo number spaces.

For the reasons set forth hereinabove in connection with claims 1-6, the Odyssey gaming machine also fails to disclose or suggest the following steps and related functions (attracting players to the image and the specific game) recited in claim 18, and by implication claims 19 and 20:

(i) changing a portion of the playing cards from displaying a portion of playing cards to displaying a portion of a display object wherein the portions of the display object create a single identifiable composite display object other than said playing cards; and,

(ii) changing in a predetermined, non-random sequence at a predetermined speed an additional portion of the playing cards from displaying a portion of playing cards to

displaying a portion of a display object wherein the portions of the display object create a single identifiable composite display object other than said playing cards.

Lastly, and for the reasons set forth hereinabove in connection with claims 1-6, the Odyssey gaming machine also fails to disclose or suggest each of the following elements and related functions (attracting players to the image and the specific game) recited in claim 21, and claims 22-24 by implication.

(i) a fourth memory portion physically configured with computer program instructions that would cause the gaming apparatus to change in a predetermined, non-random sequence at a predetermined speed from displaying the playing cards to displaying a portion of a display object inside the playing cards; and,

(ii) wherein the portions of the display object create a single identifiable composite display object other than said playing cards.

Therefore, the claims are patentably distinct from the Odyssey gaming machine, Scott et al., Hedrick et al., Carmean, and any combination thereof.

Turning to the rejection of dependent claim 5 under 35 U.S.C. 103 as being unpatentable over the Odyssey gaming machine in view of Scott et al., Hedrick et al., Carmean and Pascal et al., it is respectfully submitted that Pascal et al. also fails to disclose or suggest the elements or steps and related functions (attracting players to the image and the specific game) identified hereinabove as missing from the teachings of the Odyssey gaming machine, Scott et al., Hedrick et al. and Carmean.

Turning to the rejection of dependent claim 6 under 35 U.S.C. 103 as being unpatentable over the Odyssey gaming machine in view of Scott et al., Hedrick et al., Carmean, Pascal et al. and Alcorn et al., it is respectfully submitted that Alcorn et al. also fails to disclose or suggest the elements or steps and related functions (attracting players to the image and the specific game) identified hereinabove as missing from the teachings of the Odyssey gaming machine, Scott et al., Hedrick et al., Carmean and Pascal et al.

It is therefore respectfully submitted that claims 1-24 recite patentable subject matter over the Odyssey gaming machine, either alone or with any combination of Scott et al., Hedrick et al., Carmean, Pascal et al. or Alcorn et al. Reconsideration is respectfully requested.

**BENNETT (U.S. PATENT NO. 6,015,346)**

During the interview, the examiner brought the above patent reference to the attention of the applicant's representative. As referenced in the Interview Summary of June 15, 2005, the examiner stated that, in light of the above amendments, new potential art would need to be considered with respect to Bennett (U.S. Patent No. 6,015,346).

Bennett teaches a slot machine providing a video display screen controlled to display indicia images arranged in a matrix. A player selects pairs of indicia to cause the indicia to change to reveal associated prize values not initially displayed. The matrix of indicia may be representations of overturned cards (card backs) or rotatable blocks, wherein the indicia will change by flipping the cards face up (card fronts) or rotating the blocks to reveal a second face. When the game commences, the indicia may make up a picture or other graphic image. However, the first displayed items (e.g., the playing cards, the blocks or the picture) do not change in a predetermined, non-random sequence at a predetermined speed to display portions of a display object that create a single identifiable composite image other than the first displayed items.

In particular, the indicia change as selected by a player, as opposed to changing the indicia in a predetermined, non-random sequence. Further, the images of the playing cards (front and back) do not progressively change to portions of a display object to create a single identifiable composite image other than the card fronts and the card backs. Likewise, the images of the rotating blocks do not progressively change to portions of a display object to create a single identifiable composite image other than the blocks. In addition, the images of a picture or graphic image do not progressively change to portions of a display object to create a single identifiable composite image other than the picture or graphic image. As a result, Bennett does not disclose changing a plurality of first displayed items in a predetermined, non-random sequence at a predetermined speed to display a portions of a display object that create a single identifiable composite image other than the first displayed items.

Therefore, the claims are patentably distinct from Bennett, as well as the Odyssey gaming machine, Scott et al, Hedrick et al., Carmean, and any combination thereof.



### CONCLUSION

Based on the foregoing amendments and remarks, the applicant submits that all pending claims are novel and non-obvious and are in condition for allowance. The references do not disclose all the elements of the claims. In the light of the foregoing, the prompt issuance of a notice of allowance is respectfully solicited. Should the Examiner have any questions, he is respectfully invited to telephone the undersigned.

Respectfully submitted,

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